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Our Case No. 9623/340

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Dominic Cheung)
Serial No. *not yet assigned*) Examiner *not yet assigned*
Filing Date: August 3, 2001) Group Art Unit No.: *not yet assigned*
For SEARCH ENGINE ACCOUNT)
MONITORING)

PETITION UNDER 37 C.F.R. 1.183

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants respectfully request waiver of the requirement under 37 C.F.R. § 1.52(e) for including in the transmittal letter and specification of the patent application filed herewith a list of the names of the files contained on the disk, with other identifying information. The number of files on the enclosed disk is too great to practically include such a list.

Background

For filing electronic documents that are to become part of permanent records of the U.S. Patent and Trademark Office, 37 C.F.R. § 1.52(e) provides that such documents may be submitted on a compact disc read only memory (CD-ROM) or compact disk-recordable (CD-R). Rules are provided for format and content of the submission.

Among the information to be provided is a list of the files contained on the submitted compact discs. This information must be provided in two places when submitting a compact disk as part of a patent application. "The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph..., identifying each compact disc by the names of the files contained on each of the compact discs, their date of

creation and their sizes in bytes.” 37 C.F.R. § 1.52(e)(5) (2001). Further, “[t]he transmittal letter must list for each compact disc … a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation....” 37 C.F.R. § 1.52(e)(3)(ii) (2001).

Accordingly, the currently-established rules for submitting documents in electronic form on CD-ROM or CD-R require listing of the names of all files in both the patent application and transmittal letter.

The Present Application

A source code appendix is included with the present application. In accordance with 37 C.F.R. § 1.52(e), the source code appendix has been stored on two identical CD-R compact discs in IBM-PC format under the MS-Windows operating system. On the compact discs filed with the application, at the top directory level of each disc is a file named “dir_s” which identifies each file on the compact disc by the names of the files, their date of creation and their sizes in bytes. Also at the top directory level of each disc is a folder named “Goto” which contains 19 sub-folders including the files identified in the file dir_s. The total number of files contained on the CD-R compact disc is 23,815. The total number of bytes contained on the CD-R compact disc is 106,393,874.

The file dir_s is approximately 887 pages long, which can not be reasonably included in the incorporation by reference in the specification of the present application or in the transmittal letter for the present application. Including such a large file in printed form in the patent specification and transmittal letter would produce a patent file which is inconvenient to handle and process within the U.S. Patent and Trademark Office. Expenses for photocopying, data capture and other processing will be unduly increased both for the application and any continuation or divisional applications, and for any patents which may be granted on such applications. The first and last pages of the file dir_s are attached with this petition for illustrative purposes.

Accordingly, it is proposed to include in the incorporation by reference of the specification of the present application a reference to the file dir_s on the compact disc which identifies each file on the compact disc. The present patent application has been filed with the following incorporation by reference:

A compact disc appendix is included containing computer program code listings pursuant to 37 C.F.R. 1.52(e) and is hereby incorporated by reference in its entirety. The total number of compact discs is 1 including 23,815 files and 106,393,874 bytes. The files included on the compact disc are listed in a file entitled "dir_s" on the compact disc. Because of the large number of files contained on the compact disc, the required listing of file names, dates of creation and sizes in bytes is included in the file dir_s on the compact disk and incorporated by reference herein. The compact disk contains program code files in ASCII format.

It is further proposed to include in the transmittal letter a reference to the file dir_s on the compact disc which identifies each file on the compact disc. The transmittal letter for the present application includes the following information:

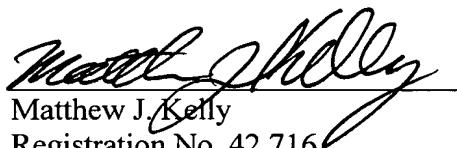
Enclosed are: ... two identical compact discs marked COPY 1 and COPY 2 and having a CD-R appendix containing computer source code in IBM-PC format compatible with MS-Windows operating system; a list of files contained on the compact discs is provided in a file at the top directory level of each compact disc in a file called "dir_s"

Accordingly, because of the extraordinary situation created by the large number of files -- 22,808 files -- contained on the compact discs filed with the present application, Applicants respectfully request waiver of the requirement under 37 C.F.R. § 1.52(e) for inclusion of a list of files contained on each compact disc. Applicants further request approval of the above-quoted incorporation by reference and listing of the transmittal filed with the present application in fulfillment of the requirements of 37 C.F.R. § 1.52(e).

Fee payment

A check in the amount of \$130.00 is enclosed for the Petition fee under 37 C.F.R. § 1.17(h). Any additional fee required may be charged or credit for any excess fee may be paid to Deposit Account No. 23-1925.

Respectfully submitted,


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